REMARKS

Claims 1-21 are pending in the instant application. Claims 14-21 have been withdrawn from consideration. Claims 1-13 have been rejected by the Examiner.

By the above Amendments, Claims 1, 2, 3, 4, 5, 7 and 10 have been amended to limit the compounds of formula (I) to those wherein q is 0 (R^6 is absent). Applicants submit that the amendments are fully supported by the specification as filed (see for example, page 34, lines 13-14), and that no new matter is being added. Applicants further submit that the Amendments narrowing the scope of Claims 1, 2, 3, 4, 5, 7 and 10 are being made solely to advance the prosecution of the instant application and are not in any way to be construed as an admission that the canceled material is unpatentable. Thus, Applicants reserve the right to pursue coverage of the canceled material by filing a continuation or a divisional application at an appropriate time in the future.

By the above Amendments, Claims 1 and 4 have been further amended to correct a typographical error in the previously presented amendment. Applicants maintain that the amendments are fully supported by the specification as filed and that no new matter has been added.

After entry of the amendments, Claims 1-13 will remain pending and under consideration. Reconsideration of the captioned application based on the previous amendments and following remarks is respectfully requested.

The rejection of Claims 1-13 under 35 USC 112, first paragraph has been maintained by the Examiner. The Examiner states that "The different hetero groups have different heteroatoms with different bonding and geometry, planar arrangements. All hetero groups do not react and rearrange in the same way. The reactions are also dependent upon the different size of the groups. Hence reactions would be different."

Applicants respectfully request clarification of this rejection. Applicants ask the Examiner to point out the position(s) of the hetero groups on the compounds of formula (I) to which the Examiner is referring, the reactions which the Examiner alleges are not enabled and the reasoning for said allegations.

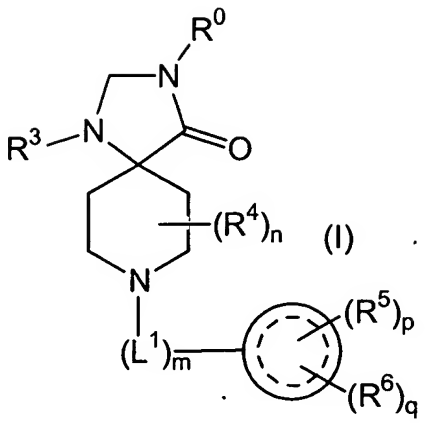
Applicants further respectfully maintain that the Examiner has failed to make a *prima facie* case for non-enablement, by failing to provide any rationale for why the specification as filed in not enabling for hetero groups. Applicants submit that "... it is incumbent on the Patent Office, whenever a rejection on this basis is made, to explain why it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning that is inconsistent with the contested statement." *in re Marzocchi and Horton,* 439 F.2d. 220, 169 U.S.P.Q. 367 (C.C.P.A. 1971)

Applicants therefore respectfully request that the Examiner provide an appropriate basis for this 35 USC 112, first paragraph rejection, so that Applicants will have an opportunity to adequately respond to the allegations or in the alternative, to withdraw the rejection as being improper.

Claims 1-13 have been rejected under 35 U.S.C. §103(a) as allegedly unpatentable over US 6,777,421, Jordan et al. More specifically, the Examiner states "The scope of some of the substituents is larger than other substituents in the prior art. R2 amongst others is an hydroxyaminoC1-6alkyl group. ... Even though it is claimed generically, one of skill in the art would be motivated to make the Oh substituted compounds since the teaching is there, and it would be obvious to obtain the compounds of the invention."

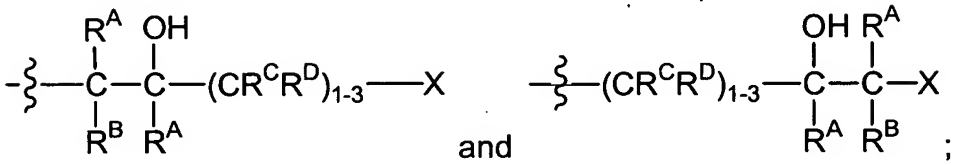
Applicants respectfully traverse the rejection. Applications submit that as defined in the teachings of Jordan et al., (see column 9, lines 46-55) the R^2 hydroxyaminoC_{1-6}alkyl group corresponds to group of the structure  (i.e. a C_{1-6}alkyl group substituted with an amine, where the amine is further substituted with a hydroxy group).

The present invention is directed to compounds of formula (I)



(I)

wherein R^0 is selected from the group consisting of



and

;

wherein X is NR^1R^2;

and wherein each R^1 and R^2 is independently selected from the group consisting of hydrogen, C_{1-8}alkyl, C_{1-8}alkoxy, C_{1-8}alkoxycarbonyl, cycloalkyl, cycloalkyl-C_{1-4}alkyl, partially unsaturated carbocylyl, partially unsaturated carbocyclyl-C_{1-4}alkyl, aryl, arC_{1-4}alkyl, arC_{1-4}alkoxy, -C(O)-C_{1-6}alkyl, -C(O)-aryl, -C(O)-arC_{1-4}alkyl, -C(O)O-cycloalkyl, –C(O)O-aryl, -C(O)O-arC_{1-4}alkyl and -C(O)O-(partially unsaturated carbocyclyl); wherein the C_{1-8}alkyl, cycloalkyl, partially unsaturated carbocyclyl, aryl or arC_{1-8}alkyl group, whether alone or part of a substituent group, is optionally substituted with one or more substituents independently selected from halogen, hydroxy, carboxy, C_{1-4}alkyl, C_{1-4}alkoxy, trifluoromethyl, trifluoromethoxy, nitro, cyano, -C(O)-C_{1-4}alkyl, C_{1-4}alkoxycarbonyl, $N(R^E)_2$, $N(R^E)_2$-C_{1-4}alkyl, $N(R^E)$-C(O)$C(CH_3)_3$, -C_{1-4}alkyl-$N(R^E)$-C(O)O-C_{1-4}alkyl and –$N(R^E)$-C(O)O-C_{1-4}alkyl, aryl, aryloxy, cycloalkyl, heteroaryl, aryl substituted heteroarylaminosulfonyl or C_{1-6}alkylthio.

Applicants submit that the R^0 group on the compounds of the present invention does not include the R^2 hydroxyaminoC_{1-6}alkyl group as disclosed by Jordan et al., as this would require that one of R^1 or R^2 be hydroxy. Thus Applicants maintain that the teachings in Jordan et al. (US 6,777,421) would not motivate one skilled in the art to make the compounds of the present invention.

Applicants further respectfully refer the Examiner to the Federal Circuit Decision *In re Baird*, 16 F.3d 380, 29 U.S.P.Q.2d 1550, 1552 (Fed. Cir. 1994), and submit that as in Baird, there is no suggestion within the disclosure of Jordan et al (US 6,777,421) to select the specific substituents which would result in the compounds of the present invention. Thus, Applicants urge that the teachings of Jordan et al. (US 6,777,421) do not render the present invention obvious.

Finally, Applicants respectfully refer the Examiner to the above Amendments of Claims 1, 2, 3, 4, 5, 7 and 10 which narrow the scope of the currently claimed compounds to compounds of formula (I) wherein q is 0 (R^6 is absent). The compounds of the currently presented claims are thus directed to compounds of formula (I) wherein the  ring group is <u>not</u> substituted with a second ring structure. In view of these Amendments, Applicants maintain that there is no overlap between the compounds of the present invention and the compounds disclosed by Jordan et al., (US 6,777,421). Applicants further maintain that there is no suggestion or motivation in the teachings of Jordan et al., (US 6,777,421) to make the compounds of the present invention.

In view of the above, Applicants respectfully request that the rejection of Claims 1-13 under 35 U.S.C. 103(a) be withdrawn.

Claims 1-3 have been rejected under the judicially created doctrine of obviousness-double patenting as being allegedly unpatentable over Claims 1-10 of U.S. Patent 6,777,421.

Applicants respectfully traverse the rejection and submit that as discussed above, the compounds of the present invention are not obvious in view of the teachings of Jordan et al. (US 6,777,421). Applicants therefore respectfully request that the rejection under the judicially created doctrine of obviousness-double patenting be withdrawn.

In view of the above remarks, Applicants maintain that the application is in condition for allowance and passage to issue is earnestly requested.

Respectfully submitted,

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